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REMARKS

Introduction

Applicants have not amended any of the claims in the application. Claims 1 and 35 — 51 remain pending in the application. There are 6 independent claims: claims 1, 36, 40, 44, 46 and 50.

Drawings

The Patent Office has not indicated that there is anything wrong with the drawings, and Applicant assumes that they have not also been rejected by the examiner in the latest office action.

Rejection under 35 USC § 102(e)

The examiner has rejected claims 40 - 44, 46, and 48 - 51 as being anticipated by U.S. Patent 6,158,184, granted to Timmerman, Sr. et al (hereinafter Timmerman '184).

The examiner has rejected claims 40 - 44, 46, and 48 - 51 on the basis of Timmerman '184 under 35 USC § 102(e).

A granted patent under 35 USC § 102(e) is prior art as of the date of its filing. The non-provisional application that became Timmerman '184 was filed on April 14, 1998.

The present application claims priority of United States application 08/975,940. This claim to priority was made in a preliminary amendment filed concurrently with the application. Application 08/975,950 is still currently pending and Applicants have already filed a terminal disclaimer with respect to that application. The Patent Office entered the claim of priority as evidenced by the Official Filing Receipt. Applicant is not aware that the Patent Office has ever found the priority claim defective. The application was filed with copies of the oaths from the parent application 08/975,940.

Application 08/975,950 was filed November 21, 1997.

Application 08/975,950 was filed almost 6 months earlier than the application from which Timmerman '184 might claim priority.

In order for Timmerman '184 to be considered prior art under 35 USC § 102(e) against an application claiming priority of an application filed earlier than it, it must claim priority from an earlier filed application, and the earlier filed application must provide a legally sufficient disclosure under the first

1 paragraph of 35 USC §112 of the elements used as the basis for the
rejection.

Timmerman '184 does claim the benefit of earlier-filed provisional
application 60/043,835, filed on April 14, 1997 (hereinafter Timmerman
5 Provisional '835).

However, if the examiner is arguing that Timmerman Provisional '835
discloses all of the elements of the present invention, Applicants respectfully
disagree, and, of course, such a point is moot anyway as Timmerman
Provisional '835 was filed after the priority date of the present application.

10 Most importantly, the examiner in the rejection states that the shear
resisting assembly of Timmerman includes a "planar shear-resisting element"
which I believe the examiner is saying corresponds to the "planar
shear-resisting element" of the present application.

In the present application, the "planar shear-resisting element" is
15 labeled as element 10 in the drawings and is described in the specification at
page 5, line 3.

The examiner in the office action has not identified the corresponding
"planar shear-resisting element" of Timmerman '184 or Timmerman
Provisional '835.

20 Applicants can find no evidence of a "planar shear resisting element in
Timmerman Provisional '835.

With respect to the later-filed Timmerman non-provisional, figure 5,
along with figure 6, that show a "planar shear resisting element" are new
figures that do not appear in Timmerman Provisional '835.

25 Applicants do agree that in Timmerman '184, element 532 in figures 5
and 6 and elements 654A, 654B and 654C corresponds to the "planar shear
resisting element" of the claims of the present invention; however, this
matter is new to Timmerman '184 and cannot serve as the basis for a 102(e)
rejection.

30 Therefore, Applicants respectfully request that the examiner withdraw
the 102(e) rejection based on Timmerman.

Applicants also respectfully disagree with the examiner's
characterization of other parts in the Timmerman applications and the relation
to the present application. Applicants believe that the examiner has
35 improperly supplied missing elements to the teaching of Timmerman in
making the anticipation rejection.

1 Claims 1, 36, 40, 44, 46 and 50 specifically describe building a wall
comprising the following elements: a bottom plate resting on and connected
to the underlying structural component of the building, a plurality of
vertically-disposed studs resting and connected to the bottom plate, a top
5 plate resting on and connected to the vertically-disposed studs.

The examiner has stated that element 20 of figure 1 of the
Timmerman applications can be considered a "bottom plate". Applicants do
not believe that element 20 of the Timmerman '184 corresponds to the
"bottom plate" as claimed in the present application.

10 The examiner states that elements 26 and 114 rest on the bottom
plate 20. Applicants can find no evidence of this in Timmerman '184.
Elements 26 and 26A in figure 1 of Timmerman '184 do not reach the
bottom plate.

With respect to calling the Timmerman element 26 a "plurality of
15 vertically disposed studs", Applicants have reviewed the file wrappers of
Timmerman Provisional '835 and Timmerman '184, and note that element
26 is described in both Timmerman Provisional '835 and Timmerman '184,
as originally filed, at page 13, line 6, as "furring boards". See column 6, line
33 of Timmerman '184 as issued.

20 Applicants note that they were at first confused about the nature of
element 26 in both Timmerman applications; however, the above-mentioned
description in the written specification seems correct in light of figure 1 in
both applications. In figure 1 of both applications, element 26 appears on
the left-hand side of the page, halfway up.

25 Applicants respectfully disagree that element 26 shown in either
Timmerman Provisional '835 or Timmerman '184 can correspond to the
"plurality of vertically disposed studs" of the present application.

In figure 3 of Timmerman '184, element 114 is shown resting on
element 116 labeled and element 20 is not present. More importantly, figure
30 3 is labeled as showing the prior art not Timmerman's invention.

In figure 4 of Timmerman '184, Applicants also disagree with the
examiner's characterization that element 114 (described as a "trimmer" at
page 14, line 22 in the application as filed and at column 7, line 17 as
published) is connected to a bottom plate. Trimmer 114 appears to rest
35 directly on the foundation.

1 The examiner also claims that Timmerman '184 shows fasteners being
used inserted through the bottom strut to secure the shear-resisting
assembly directly resting on the underlying structural component of the
building, but has failed to indicate which elements make that connection.

5 With respect to element 110 of figure 4 of Timmerman '184,
Applicants note that this is labeled as header 110 at page 15, line 6 of the
application as filed and at column 7, line 17 as published, and the connection
to elements 114 and 115 to element 110 appears to not be described,
therefore it is improper to add information to this reference to try to reject
10 the present claims on the basis of anticipation.

With respect to the connection of the shear resisting assembly of the
present invention to the top plate, Applicants do not believe that Timmerman
'184 adequately describes how this connection is made to anticipate the
claims of this application.

15 The examiner states that fasteners 537 of Timmerman '184 connect
the top strut to the top plate 36 of the wall. Applicants respectfully
disagree. Elements 537 in figure 5 connect the top strut of Timmerman
'184 to the chords of the shear resisting assembly, not the top plate of the
wall. Applicants are unfamiliar with element 36 of Timmerman '184 and
20 request further clarification from the examiner.

The examiner appears to argue that such a connection described is
inherent to the disclosure of Timmerman. However, none of the drawings
relating to the new shear resisting assembly in either of the Timmerman
applications show this connection being made or show how the shear
25 resisting assembly is adapted to make this connection. Furthermore, element
110 is shown only in figures 4 and 6. In the specification of Timmerman
'184 as published, figures 4 and 6 are described at column 7, lines 27 to 47
and lines 59 to 67, respectively. Neither of these description say anything
about the connection of the element 110 to the shear resisting assembly of
30 Timmerman, except that the rigid structural panel "provides vertical support
for header 110". If the examiner is claiming the teaching is inherent on the
basis of these description, Applicants must respectfully disagree with the
examiner since the rigid structural panels of Timmerman could provide
vertical support to header 110 without being connected to it.

35 In comparison, claim 1 specifically calls for "fasteners having a
threaded shank portion" for making this connection.

1 Applicants respectfully request that the examiner remove the all
rejections of claims based on 35 USC §102(e).

Rejection under 35 USC §103(a)

5 The examiner has rejected claims 1, 35 — 39, 45 and 47 as being
obvious under 35 USC §103(a) in light of Timmerman '184 and U.S. Patent
No. 6,148,583, granted to Hardy (hereinafter Hardy '583).

In making the 103 rejection, the examiner relies on Timmerman '184
to supply the same elements the examiner used when making the 102
10 rejection.

As stated above, Applicants respectfully disagree that Timmerman
'184 can be considered as prior art for the elements used by the examiner.
Applicants incorporate the above argument here.

Thus, Applicants feel that the examiner's 103 rejection of claims 1, 35
15 — 39, 45 and 47 is improper and should be removed.

Applicant's also feel that the examiner has improperly shown that
Hardy '583 is prior art against the present application.

As stated above, the present application claims priority of United
States application 08/975,940, and the filing date of November 21, 1997.

20 Hardy '583 was filed on November 30, 1999, after the priority date of
the present application.

Therefore, Applicants respectfully request that the examiner withdraw
the 102(e) rejection based on the combination of Timmerman '184 and
Hardy '583.

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Rejection under 35 USC §103(a)

The examiner has rejected claim 45 as being obvious under 35 USC
§103(a) in light of Timmerman '184 and what the examiner calls an obvious
design choice.

30 In making the 103 rejection, the examiner relies on Timmerman '184
to supply the same elements the examiner used when making the 102
rejection.

As stated above, Applicants respectfully disagree that Timmerman
'184 can be considered as prior art for the elements used by the examiner.
35 Applicants incorporate the above argument here.

1 Thus, Applicants feel that the examiner's 103 rejection of claim 45 is improper, and should be removed.

Furthermore, in making the rejection of claim 45, the examiner has stated that it would be obvious to insert threaded holdown fasteners only a
5 selected distance into the first and second chords without passing all the way through the first and second chords, and that Applicants have failed to claim that this limitation solves any stated problem.

Applicants respectfully disagree with the comments of the examiner. Applicants respectfully disagree that it would be obvious to attach a holdown
10 in the manner described. Furthermore, as stated in the specification at page 10, lines 16 — 20: "As shown in Figure 10B, holdown fasteners are preferably inserted only a selected distance into the first and second chords 19 and 20 without passing all the way through the first and second chords 19 and 20. This allows the shear-resisting assembly 9 to fit closely between
15 the studs 5 of the wall 1." For a view of the close tolerance that are sometimes necessary, Applicants refer the examiner to figures 9 and 13 of the application.

Applicants respectfully request that the examiner remove the rejection of claim 45.

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Rejection under 35 USC § 103(a)

The examiner has rejected claim 47 as being obvious under 35 USC § 103(a) in light of Timmerman '184 and U.S. Patent 4,037,381, granted to Charles (hereinafter Charles '381).

25 In making the 103 rejection, the examiner relies on Timmerman '184 to supply the same elements the examiner used when making the 102 rejection.

As stated above, Applicants respectfully disagree that Timmerman '184 can be considered as prior art for the elements used by the examiner.
30 Applicants incorporate the above argument here.

Thus, Applicants feel that the examiner's 103 rejection of claim 47 is improper, and should be removed.

Furthermore, in making the rejection of claim 47, the examiner has stated that Charles '381 teaches a panel with boundary edging members 38,
35 and that the combination of Charles '381 and Timmerman '184 is obvious.

1 Claim 47 in the present application calls for the edge fasteners to pass through each of the legs of the u-shaped channels that make up the boundary edging members.

5 The examiner has not identified Charles '381 as being the source for the edge fasteners that pierce the boundary edging member, the planar shear resisting element and the top and bottom struts and the first and second chords in the specified manner of claims 46 and 47. Since Timmerman '184 cannot supply those edge fasteners, because it is not prior art, unless the examiner can show that Charles '381 has such edge fasteners disposed in
10 such an arrangement, Applicants believe it is inappropriate to say that Charles '381 teaches something that is comparable to the boundary edging member of claim 47.

Applicants respectfully request that the examiner remove the rejection of claim 47.

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Conclusion

In view of the above, Applicants submit that the claims pending in the application are in condition for allowance. Reconsideration of the rejections and objections is requested. Allowance of the rejected claims at an early date
20 is solicited.

Applicants' attorney would be happy to answer any questions the examiner may have regarding this application by phone at 510 832 4111.

Respectfully submitted,

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Date: December 2, 2003
Reg. No. 41,694

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Attachments:
Check No.: 10160 for \$950.00 ✓
Amendment transmittal (2 pages) ✓
Duplicate Ament. trans. (2 pages) ✓

35 Return Receipt Post Card ✓

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